

REMARKS

Claims 1-16, 18 and 19 were examined and were rejected on various grounds. By virtue of this response, claims 5, 6, and 17 are cancelled, claims 20-22 are added, and claims 1, 3, 7, and 14 are amended. Claims 1-4, 7-16, and 18-22 are therefore presently under consideration. Amendment and cancellation of subject matter is not to be construed as an abandonment or a dedication of any subject matter.

In view of the preceding amendments and the remarks made herein, the present application is believed to be in condition for allowance.

Objections

Claim 3 was objected to. Claim 3 was amended to replace “another” for “anther.” Applicants respectfully request withdrawal of the objection against claim 3.

Claims 5 and 6 were deemed allowable except for dependency from rejected claims. New claims 20 and 21 substantially incorporate all the limitations of claims 5 and 6, respectively. Claims 5 and 6 are therefore cancelled. Applicants therefore submit that claims 20 and 21 are presently in condition for allowance.

35 U.S.C. § 102(e)

Claims 1-4, 8, 12, and 13 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,707,247 to Murano.

Applicants submit that the rejection characterizes the second transparent layer 5 made of resin of Murano as the “second resin member” recited in claim 1. Additionally, Applicants submit that it appears the rejection characterizes the side face of second transparent layer 5 covered with reflector layer 6 of Murano as the inner wall of the second resin member.

By contrast with Murano, the inner wall of the second resin member as recited in amended claim 1 extends in a direction away from the main surface at the side where the semiconductor light-emitting element is provided, and differs from the outer wall extending at the side opposite to the side where the semiconductor light-emitting element is provided. As defined in amended claim 1, the inner wall of the second resin member functions as a reflector also on the first top surface. Such an inner wall is not disclosed or suggested by Murano. Because Murano does not teach every limitation of claim 1, Applicants respectfully submit that Murano does not anticipate claim 1 and request withdrawal of the rejection against claim 1.

Claims 2-4, 8, 12, and 13 each depend from claim 1. Because Murano does not anticipate claim 1, Murano cannot anticipate claims 2-4, 8, 12, and 13. Applicants respectfully request withdrawal of the rejections against these claims.

35 U.S.C. § 103(a)

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Murano.

Claim 11 depends from claim 1. Applicants submit that based on the current amendments of claim 1, claim 1 is not anticipated or rendered obvious over Murano. Applicants respectfully request withdrawal of the rejection.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Murano, in view of U.S. Patent No. 6,180,962 to Ishinaga.

Claim 7 has been amended to be an independent claim by incorporating the limitations of previously pending claim 1.

Applicants submit that the rejection appears to characterize “disconnection 10” in Fig. 1 of Ishinaga as the “slit-shaped groove” defined in claim 7. Disconnection 10 (and disconnection 9)

of Ishinaga are separately “provided in the Au layer of a pair of electrodes” and as such are each disconnect portions in a different electrode. The slit-shaped groove of amended claim 7 separates terminal portions of the device. Also, the disconnections of Ishinaga do not reach the back surface from the top surface of electrode 4. Thus, the disconnections of Ishinaga do not teach or suggest the “slit-shaped groove” as recited in claim 7. Applicants submit that Murano does not cure the deficiency of Ishinaga, and that claim 7 is non-obvious over this combination of references and respectfully request withdrawal of the rejection against claim 7.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Murano, in view of U.S. Patent No. 6,624,491 to Waitl.

Claim 9 depends from amended claim 1 and thereby incorporates all limitations of claim 1. Applicants submit that all the limitations of claim 9 are not taught or suggested by the proposed combination of references and respectfully request withdrawal of the rejection against claim 9.

Claims 10 and 14-16 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Murano, in view of U.S. Patent Application Publication 2003/0178691 to Wang.

Claims 10 and 13 depend from claim 1. Because amended claim 1 distinguishes the primarily reference, the proposed combination of references does not teach all the limitations of claim 10. Therefore, Applicants submit that claim 10 is allowable over Murano and Wang and request withdrawal of the rejection.

Regarding claim 14, the rejection appears to identify element 31 of FIG. 7 of Wang as being a “lead terminal projecting from the periphery of said main surface...” However, element 31 cannot teach this recitation of claim 14 because the “tip end” identified in the rejection (the cross-sectionally thinner portion) projects inward and not “from the periphery” and “extending in a prescribed direction” with a “base portion located between the periphery...and said tip end.” The rejection does not appear to suggest that Murano teaches the above recitation of claim 14. Because

neither Murano nor Wang teach or suggest all the limitations of claim 14, Applicants submit that claim 14 is allowable over the proposed combination of references and request withdrawal of the rejection against claim 14.

Claims 15 and 16 each depend from claim 14 and are therefore allowable at least by virtue of the allowability of claim 14. Applicants request the withdrawal of the rejections against claims 15 and 16.

Claims 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Murano, in view of U.S. Patent No. 6,393,222 (Nakagawa).

Claim 18 incorporates the device recited in amended claim 1. Because the combination of Murano and Nakagawa do not teach each and every limitation of claim 1, Applicants submit that this combination of references does not render claim 18 obvious. Claim 19 depends from 18 and Applicants submit that claim 19 is allowable at least by virtue of this dependency. Applicants respectfully request withdrawal of the rejections against claims 18 and 19.

New claim 22 depends from claim 1 and Applicants respectfully submit that claim 22 is allowable at least by virtue of this dependency.

CONCLUSION


In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no.

245402008400. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: February 23, 2006

Respectfully submitted,

By 
Michael S. Garrabrants
Registration No.: 51,230
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, California 94304-1018
(650) 813-4227